

THIS DISPOSITION IS NOT CITABLE June 6, 1997
AS PRECEDENT OF THE TTAB

Paper No. 39
EWH/BAG

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pacific Sea Foods Company
v.
Emerald Seafoods, Inc.

Opposition No. 84,899
to application Serial No. 73/818,728
filed on August 11, 1989

Matthew F. Jodziewicz of Arant, Kleinberg, Lerner & Ram for
Pacific Sea Foods Company

James A. Walker of Williams, Kastner & Gibbs for Emerald
Seafoods, Inc.

Before Hanak, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Emerald Seafoods, Inc. (applicant) seeks registration
of EMERALD SEAFOODS INCORPORATED and design in the form
shown below for "seafood." At the request of the Examining
Attorney, applicant disclaimed the exclusive right to use
SEAFOODS INCORPORATED apart from the mark as shown below.

The application was filed on August 11, 1989 with a claimed first use date of September 13, 1988.



Pacific Sea Foods Company (opposer) filed a notice of opposition alleging that since at least January 1945 opposer had made continuous use of its mark EMERALD BRAND for seafood, and further alleging that "registration of applicant's mark would cause members of the purchasing public to assume, contrary to the facts, that opposer's goods are associated with, sponsored or endorsed by, or in some way connected with applicant." (Notice of opposition paragraphs three and four.)

Applicant filed an answer which denied the pertinent allegations of the notice of opposition, and in particular, denied the allegations contained in paragraphs three and four of the notice of opposition.

Opposer has made of record the depositions of Robert Kronick (a supervisor employed by opposer from 1984 to

December 1986); Frank S. Lauro, Jr. (owner and manager of opposer since December 1986); and Frank Mateljan (a competitor of opposer who has known of opposer since the mid 1950's). As explained in this Board's order of June 14, 1996, applicant has made of record no evidence.

Both parties filed briefs. Neither party requested a hearing. Applicant attached to its brief two exhibits: (1) an unsigned, incomplete draft "consent agreement" purportedly between opposer and applicant; and (2) the declaration of Eric Maisonpierre (sales manager of applicant). Both exhibits are untimely in that they were not (even if they could have been) made of record during applicant's testimony period. Moreover, the unsigned, incomplete draft "consent agreement" purportedly between the parties is, as more fully explained in this Board's order of June 14, 1996, inadmissible as evidence pursuant to Federal Rule of Evidence 408. As for the declaration of Mr. Maisonpierre, in inter partes proceedings before the Board, declarations or affidavits do not constitute evidence unless the parties so stipulate, which they have not. Trademark Rule 2.123(b).

There are two issues in this proceeding: (1) priority of use and (2) likelihood of confusion.

Opposer has established that it has used the marks EMERALD and EMERALD BRAND on boxes and bags containing frozen halibut since the mid 1950's. This use has continued to the present. Opposer sells EMERALD BRAND frozen halibut

to seafood brokers and restaurants. Since December 1986, opposer has sold other types of fish under its EMERALD BRAND mark including swordfish, salmon and tuna.

Because applicant has made of record no evidence, its earliest "proven" first use date is the filing date of its application, namely, August 11, 1989. In any event, opposer's first use of its EMERALD BRAND trademark for seafood long predates even applicant's claimed first use of its mark EMERALD SEAFOODS INCORPORATED and design, namely, September 13, 1988.

Because priority of use favors opposer, we turn to the issue of likelihood of confusion. In any likelihood of confusion analysis, two key considerations are the similarities of the goods and the similarities of the marks. Federated Foods, Inc. v. Fort. Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

In this case, the goods are legally identical. Applicant's own chosen description of goods is simply "seafood." Obviously, the term "seafood" encompasses all types of seafood including halibut.

Turning to a consideration of the marks, we note that "when marks would appear on virtually identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."

Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In this case, the word portions of both marks begin with the word EMERALD. Moreover, the word EMERALD is the only true source identifying word in the word portions of both marks. The word BRAND in opposer's mark does not indicate source. The words SEAFOODS INCORPORATED in applicant's mark have been quite properly disclaimed. The word SEAFOODS is simply a generic term for applicant's goods. Moreover, the word INCORPORATED merely describes applicant's legal status. Thus, the only source identifying feature of opposer's word mark and the word portion of applicant's mark is the identical, arbitrary term EMERALD. While it is true that applicant's mark contains a design, we note that this design depicts an emerald and two fish. The depiction of an emerald serves to emphasize the word EMERALD in the word portion of applicant's mark. Moreover, the depiction of two fish merely reiterates the nature of applicant's goods, "seafood."

In short we find that the use of opposer's mark and applicant's mark on identical goods is likely to result in confusion.

Decision: The opposition is sustained.

E. W. Hanak

T. J. Quinn

C. E. Walters
Administrative Trademark
Judges, Trademark Trial
and Appeal Board